

Atty. Docket No.: 2000/US
Previously (40222.0003US01)
Serial No.: 09/939,141

REMARKS

This Amendment and Response is submitted in response to the Notice of Non-Compliant Amendment “Notice” dated February 3, 2004, and relating to the Office Action dated March 27, 2003. In the Notice, the Examiner noted improper status identifiers for the claims. Since it appears claim amendments submitted on August 27, 2003, and December 22, 2003, have not yet been entered due to formality requirements, Applicant submits herewith a new Amendment with proper status identifiers and restates Remarks submitted in the Amendment dated August 27, 2003, for the Examiner’s convenience.

Applicant has amended claims 14, 15, 16, and 21-27. Reconsideration of the pending claims is respectfully requested. It is believed that the application and claims are in condition for allowance. Such allowance is respectfully requested.

Objection To Claims 16 and 21-27

Claims 16 and 21-27 were objected to for minor informalities within the claim language. Applicant agrees with the Examiner and has corrected the problematic language where appropriate. As such, Applicant respectfully requests that the claim objection be withdrawn.

Rejection Under §112, Second Paragraph

Claims 14-16 were rejected under 35 U.S.C. §112, second paragraph. The Examiner contends that claims 14-16 include problematic language that make each of these claims indefinite. Applicant has amended claims 14, 15, and 16 above in accordance with the Examiner’s suggestions. Accordingly, Applicant request that the §112, second paragraph rejection be withdrawn.

Rejection Under §102 Addressed

The Examiner rejected claims 1-3, 5, 8, 12, 15-16, and 21 under 35 U.S.C. §102(b) as anticipated by JP 61-271323. This rejection is respectfully traversed with respect to these claims. Reference JP 61-271323 does not teach or suggest the claim limitations found in claims 1-3, 5, 8, 12, 15-16 or 21. In particular, claim 1 recites “[a] method for the production of a

polymer having at least one unit that contains at least one cyclopentanone structure condensed with at least two aromatic rings,” JP 61-271323 teaches the production of a polymer (black deposit) having conductivity. The compositions of the black deposit is unspecified in the reference, and one of ordinary skill in the art would likely believe that the black deposit is a polymer having a cyclopentane structure condensed with at least two aromatic rings. The JP 61-271323 reference never teaches or suggests a method of producing a polymer having at least one unit that contains at least one cyclopentanone structure Therefore, Applicants respectfully request withdrawal of the rejection.

Rejection Under §103 Addressed

The Examiner rejected claims 4 and 9-11 as obvious in view of JP 61-271323 in light of skill in the art at the time the invention was made. This rejection is respectfully traversed with respect to these claims. Since JP 61-271323 does not teach or suggest the claim limitations found in claim 1, it does not teach or suggest the claim limitations in claims 4 or 9-11, and as such Applicant respectfully request withdrawal of the §103 rejection.

In addition, Applicant does not believe that it would have been obvious to one having ordinary skill in the art to include an ester in a method to produce a polymer having at least one unit that contains at least one cyclopentanone structure, as one of ordinary skill in the art would expect to form a cyclopentane containing structure instead. Applicant’s methods include an ester as a reaction constituent, for example, necessary for producing poly(fluorenone) by electrolysis of poly(fluorene), *i.e.*, the ester being required to produce the cyclopentanone structure during electrolysis. As such, Applicant believes that one of skill in the art would not choose to incorporate an ester as a reaction constituent, or even necessarily as a reaction solvent, in producing the cyclopentanone containing structure, because one of ordinary skill in the art would believe that a cyclopentane containing structure would be formed instead. Therefore, Applicant believes that claims 4 and 9-11 are patentably distinct from JP 61-271323 and the motivation of one having ordinary skill in the art. For this additional reason, Applicant respectfully request withdrawal of the §103 rejection.

Atty. Docket No.: 2000/US
Previously (40222.0003US01)
Serial No.: 09/939,141

Allowable Claims

The Examiner indicated that claims 6, 7, 13, 14, and 22-27 would be allowable if rewritten in independent form including all of the limitations of the limitations of any base claims and intervening claims.

The Examiner also indicated claim 14 and 22-27 would be allowable if amended to overcome the Examiner's claim objections and/or rejections under 35 U.S.C. §112.

Applicant notes that these claims have been amended to overcome the Examiner's claim objections and rejections with respect to 35 U.S.C. §112. In light of the amendments above and the preceding remarks, Applicant respectfully request allowance of the pending claims.

CONCLUSION

Claims 1-16 and 21-27 remain pending in the application. In light of the foregoing Amendment and remarks to Office Action, it is believed that the application is in condition for allowance, which is respectfully solicited.

Applicant believes no fees are due in connection with this Amendment. However, any fees can be charged to Deposit Account 04-1415. The Examiner is encouraged to contact the undersigned to resolve any questions regarding this Amendment.

Signed at Denver, Colorado, this 2nd day of March 2004.

Respectfully Submitted,



Paul J. Prendergast

Reg. No.: 46,068

DORSEY & WHITNEY LLP

USPTO Customer Number 20686

PJP/CAF